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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,086	06/21/2005	Philip James Gunning	94090	9264
24628	7590	08/06/2009		
Husch Blackwell Sanders, LLP			EXAMINER	
Husch Blackwell Sanders LLP Welsh & Katz			JARRELL, NOBLE E	
120 S RIVERSIDE PLAZA				
22ND FLOOR			ART UNIT	
CHICAGO, IL 60606			PAPER NUMBER	
			1624	
			MAIL DATE	
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			08/06/2009	
			PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/531,086

Applicant(s)

GUNNING ET AL.

Examiner

NOBLE JARRELL

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-12 and 14-34 is/are pending in the application.
- 4a) Of the above claim(s) 20-22 and 24-31 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23, 32 and 33 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12, 15-19 and 34 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group I in the reply filed on 12 December 2008 is acknowledged. The traversal is on the ground(s) that claim 23 should belong in group I. This is found persuasive because claim 23 is drawn to the preparation of 3 β -OH sapogenins. As a result of claim dependence, claims 32-34 are now part of group I as well (In other words, group III is combined with group I). Old group III is considered distinct from old group IV because the products in each parent claim

The requirement among new group I, and original groups II and IV is still deemed proper and is therefore made FINAL.

2. In the current claims set, claims 1-4, 6-12, and 14-34 are pending. Claims 20-22 and 24-31 are withdrawn from consideration. Claim 13 has been cancelled. Consequently, claims 1-4, 6-12, 14-19, 23, and 32-34 are being examined on the merits.

Claim Objections

3. Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 13 is objected to because it depends on cancelled claim 13.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4, 6-12, 15-19, and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4, 6-12, 15-19, and 34 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the steps that are required for the conversion of a 3 β -OH compound to a 3 β -O-linked sugar or 3 β -organic ester group. Applicants have not specified within the claims what method steps are required for these conversions. On the other hand, applicants have specified how the 3 β -OH is formed, by use of a hindered organoborane (as a reducing agent). A separate step is required for the derivatization of the 3 β -OH group. It is unclear what synthetic steps are required for these conversions consequently.

Allowable Subject Matter

6. Claims 23, 32, and 33 appear free of the prior art of record (it is noted that claims 32 and 33 appear free of the prior art of record only in relation to claim 23, **not** claims 22, 24, or 25, because these claims are withdrawn).

7. These claims appear free of the prior art of record because the closest prior art of record is taught by Djerash et al.. (*Journal of the American Chemical Society*, **1953**, 75(20), 4885-87) teach the preparation of 3 α -OH with sodium borohydride. Djerash et al. do not teach the preparation of 3 β -OH compound that is encompassed by these claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NOBLE JARRELL whose telephone number is (571)272-9077. The examiner can normally be reached on M-F 7:30 A.M - 6:00 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Noble Jarrell/
Examiner, Art Unit 1624

**/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624**